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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/552,313

09/11/2006

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06/26/2008

EXAMINER

DONADO, FRANK E

ART UNIT

PAPER NUMBER

4173

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/552,313	Applicant(s) SCHWEIGER ET AL.	
	Examiner FRANK DONADO	Art Unit 4173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09/11/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 21 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20, 22-26, 28 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09/11/06 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/07/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 6, 13, 19 and 20 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are replete with indefinite language, as evidenced by use of the phrase "can be". The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Olds.

Regarding claim 1, Olds teaches a communications system for mobile radio telephony comprising mobile devices (**Column 3, lines 44-46, Column 4, lines 15-16 and Figure 1**), comprising modules which can be inserted into the mobile devices, with at least one subscriber territory being fixed inside the total territory covered by the communications system (**Subscriber Identification Modules (SIM's) are inserted into the mobile units that correspond to a specific portion of the population and to each individual subscriber, Column 4, lines 24-31**), within which subscriber territory communication takes place from and/or to the mobile devices under special conditions (**Column 4, lines 16-20**), and comprising means by which it can be determined whether the mobile device is located inside the subscriber territory, characterized in that the means are arranged on the module or in a determination unit which can be accessed by means of remote polling (**Mobile Units communicate with a Control Station that receives SIM information, and the location of the mobile units anywhere in the world can then be determined Column 4, lines 45-47 and 48-52**).

Regarding claim 2, Olds teaches a communications system in accordance with claim 1, wherein the module is the subscriber identification module (SIM) (**Column 4, lines 24-25**).

Regarding claim 3, Olds teaches a communications system in accordance with claim 1, wherein location areas in which one or more radio cells are located are

arranged in the total territory covered by the communications system (**Abstract, lines 7-10, Figure 5, wherein 72 represents the territory and Figure 2, wherein 36 represents a cell**).

Regarding claim 4, Olds teaches a communications system in accordance with claim 3, wherein location areas and/or the radio cells have identity data characterizing them (**A target area is identified through coordinates, Column 9, lines 1-3**).

Regarding claim 5, Olds teaches a communications system in accordance with claim 4, wherein the identity data include identifiers (**Cell ID's, Column 5, lines 15-18**) and coordinates (**Column 9, lines 1-3**).

Regarding claim 6, Olds teaches a communications system in accordance with claim 4, wherein means are provided in the communications system by means of which the identity data of the location areas and/or of the radio cells can be transmitted to the mobile devices (**Column 6, lines 3-11**).

Regarding claim 7, Olds teaches a communications system in accordance with claim 1, wherein an interface is provided in the mobile devices by means of which the identity data can be transmitted to the module (**Cell ID information is transmitted to the mobile unit, Column 10, lines 29-34 and Figure 8**).

Regarding claim 8, Olds teaches a communications system in accordance with claim 1, wherein means are provided in the module and/or in the determination unit of the communications system by means of which the identity data of the location area or radio cell in which the mobile device is located can be compared with data characterizing the subscriber territory **(A broadcast signal is periodically transmitted through a beam containing cell ID information, and the broadcast process includes obtaining a current service area definition Column 6, lines 1-11 and Column 14, lines 1-2).**

Regarding claim 9, Olds teaches a communications system in accordance with claim 8, wherein the data characterizing the subscriber territory include identifiers and coordinates of the locations areas and/or radio cells located in the subscriber territory **(Coordinate information called beam center point coordinates are determined for the service area corresponding to each cell, Column 14, lines 44-49).**

Regarding claim 10, Olds teaches a communications system in accordance with claim 8, wherein the data characterizing the subscriber territory are stored in the module and/or in the determination unit **(Service area information is stored in the SIM, which is part of the subscriber database, Column 4, lines 25-27).**

Regarding claim 11, Olds teaches a communications system in accordance with claim 1, wherein the means by which it can be determined whether the mobile device is

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located inside the subscriber territory are designed such that it can be determined by them whether the coordinates of a location area or of a radio cell of the communications system are disposed in a region which is fixed by a location and the radius of a circle surrounding the location as a center **(A target area that is the same as the “known mobile unit location” and its coordinates are defined and used to determine whether mobile device is located inside home location, Column 8, lines 44-46 and 51-54, and Column 9, lines 1-5 and Figure 5).**

Regarding claim 12, Olds teaches a communications system in accordance with claim 11, wherein the coordinates of the location and the radius are stored in the module or in the determination unit **(Known location information, same as target area information, is stored in the SIM, Column 4, lines 27-31 and 51-54 and Figure 6).**

Regarding claim 13, Olds teaches a communications system in accordance with claim 11, wherein the identifiers of the location areas and/or of the radio cells are designated such that they are in an unambiguous relationship with the coordinates of the location area and/or of the radio cell so that the coordinates can be determined from the identifiers **(Each cell has its own unique cell ID, Column 5, lines 15-18 and Figure 2).**

Regarding claim 14, Olds teaches a communications system in accordance with claim 13, wherein means are provided in the module or in the determination unit by which the coordinates can be determined on the basis of the identifiers **(In a broadcast process, a Control Station determines coordinate information called beam center point coordinates for the service area, along with cell ID, corresponding to each cell , Column 14, lines 29-30 and 44-57).**

Regarding claim 15, Olds teaches a communications system in accordance with claim 1, wherein the module and/or the determination unit has means by which it can be determined whether the identifier of a location area and/or of a radio cell coincides with a predetermined identifier of the location area and/or of the radio cell of the subscriber territory **(Beams carrying cell ID information are periodically transmitted, service area identification is predetermined and current service area information is then determined from current cell ID information transmitted over the beam, Column 6, lines 3-11 and Column 14, lines 38-49).**

Regarding claim 16, Olds teaches a communications system in accordance with claim 15, wherein the predetermined identifier is stored in the module or in the determination unit **(Service area information is stored in the SIM, which is part of the subscriber database, Column 4, lines 25-27).**

Regarding claim 17, Olds teaches a communications system in accordance with claim 16, wherein the identifiers stored in the module or in the determination unit are at least partly stored in a form reducing the storage requirements **(The manner in which the service area information is stored in the SIM helps reduce the amount of faulty registrations, Column 9, lines 41-44 and 48-55).**

Regarding claim 18, Olds teaches a communications system in accordance with claim 1, wherein the determination unit has a transmitter and receiver unit **(A control station is the determination unit and transmits and receives information, Column 8, lines 25-29 and 43-44)**, with the transmitter unit serving the reception of a poll of the association with a subscriber territory and the transmitter unit serving the transmission of the result of the examination whether the mobile device is located in a subscriber territory **(Column 8, lines 34-36 and 40-42).**

Regarding claim 19, Olds teaches a communications system in accordance with claim 1, wherein an interface is provided between the mobile device and the module via which the information whether the mobile device is located in a subscriber territory can be transmitted from the module to the mobile device in the form of a control signal **(The mobile unit communicates with the Control Station that includes the SIM and the determination is made as to whether the mobile unit location is within its service area, Column 4, lines 48-52).**

Regarding claim 20, Olds teaches a method of operating a communications system for mobile radio telephony comprising mobile devices (**Column 3, lines 44-46, Column 4, lines 15-16 and Figure 1**) and comprising modules which can be inserted into the mobile devices, with at least one subscriber territory being fixed inside the total territory covered by the communications system (**Subscriber Identification Modules (SIM's) are inserted into the mobile units that correspond to a specific portion of the population and to each individual subscriber, Column 4, lines 24-31**) inside which subscriber territory communication takes place from and/or to the mobile devices under special conditions (**Column 4, lines 16-20**), and with a determination taking place whether the mobile device is located in the subscriber territory, characterized in that the determination takes place by means of the module or by means of a determination unit which is accessed by means of remote polling (**Mobile Units communicate with a Control Station that receives SIM information, and the location of the mobile units anywhere in the world can then be determined Column 4, lines 45-47 and 48-52**).

Regarding claim 22, Olds teaches a method in accordance with claim 20, wherein the examination whether the coordinates of a location area and/or of a radio cell are disposed in a region which is fixed by a location and the radius of a circle surrounding the location as a center takes place by means of the module and/or of the determination unit (**A target area that is the same as the "known mobile unit**

location” and its coordinates are determined by a Control Station, Column 8, lines 44-46 and 51-54 and Column 9, lines 1-5 and Figure 5).

Regarding claim 23, Olds teaches a method in accordance with claim 1, wherein an examination whether the identifier of a location area or of a radio cell coincides with a predetermined identifier of a location area or of a radio cell takes place by means of the module and/or of the determination unit **(Beams carrying cell ID information are periodically transmitted, service area identification is predetermined and current service area information is then determined from current cell ID information transmitted over the beam, Column 6, lines 3-11 and Column 14, lines 38-49).**

Regarding claim 24, Olds teaches a method in accordance with claim 22, wherein the examination in accordance with claim 23 takes place prior to the examination in accordance with claim 22 **(The known location coordinates that are used as evaluation technique data are used to subsequently interpret service area information, Column 9, lines 38-40 and 48-51).**

Regarding claim 25, Olds teaches a method in accordance with claim 20, wherein the location and the radius of the region in accordance with claim 22 and/or the predetermined identifiers in accordance with claim 23 are stored in the module and/or in the determination unit **(Cell ID's are a part of the subscriber database that is included as part of the SIM information, Column 4, lines 25-27).**

Regarding claim 26, Olds teaches a method in accordance with claim 25, wherein the predetermined identifiers are at least partly stored in a manner reducing the memory requirements in the module and/or in the determination unit **(The manner in which the service area information is stored in the SIM helps reduce the amount of faulty registrations, Column 9, lines 41-44 and 48-55).**

Regarding claim 28, Olds teaches a method in accordance with claim 20, wherein the identifier of the location area and/or of the radio cell and/or their coordinates are forwarded by a transmitter and receiver station to the mobile device and from this to the module **(The registration process request allows for routing of a request message to an appropriate Switching Office, after which known location data are transmitted to the mobile unit and subsequently back to the control station so the known location may be recorded in the SIM, Column 13, lines 54-56, Column 14, lines 18-20 and Column 4, lines 27-31 and 48-52).**

Regarding claim 29, Olds teaches a method in accordance with claim 28, wherein the data forwarded from the mobile device to the module are transmitted from this to the determination unit **(During registration with a Switching Office that did not handle a previous registration, the Switching Office will request mobile unit information from the SIM, Column 13, lines 54-56 and 61-65);** and in that the determination unit--after an examination whether the mobile device is located in a

subscriber territory--forwards the result to the mobile device and the latter to the module **(The registration process request allows for routing of a request message to an appropriate Switching Office, after which known location data are transmitted to the mobile unit and subsequently back to the control station so the known location may be recorded in the SIM, Column 13, lines 54-56, Column 14, lines 18-20 and Column 4, lines 27-31 and 48-52).**

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 6,385,458 refers to priority handling of location services in a mobile communications network.

US Patent No. 5,802,468 refers to a system and method for identifying call areas within a communication system.

US Patent No. 6,018,653 refers to multiple-level home area pricing for cellular mobile telephones.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK DONADO whose telephone number is (571)

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270-5361. The examiner can normally be reached on Monday-Thursday, 7:30 am -5 pm, alternate Fridays, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benny Tieu can be reached on 571-272-7490. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Frank Donado
Art Unit 4173

/Lewis G. West/
Primary Examiner, Art Unit 2618